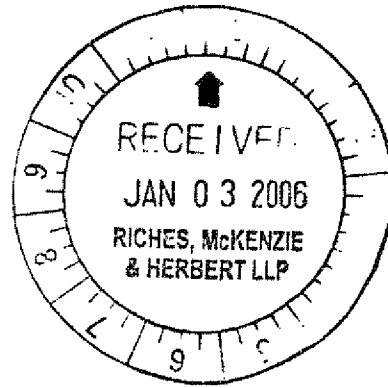




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December 28, 2005

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Application No. : **2,458,337**  
Owner : DISCOVERY COMMUNICATIONS, INC.  
Title : **ELECTRONIC BOOK WITH BOOKMARK FEATURE**  
Classification : G06F-19/00  
Your File No. : **P16504**  
Examiner : Kristina Deczky

YOU ARE HEREBY NOTIFIED OF :

- A REQUISITION BY THE EXAMINER IN ACCORDANCE WITH SUBSECTION 30(2) OF THE *PATENT RULES*;
- A REQUISITION BY THE EXAMINER IN ACCORDANCE WITH SECTION 29 OF THE *PATENT RULES*.

IN ORDER TO AVOID **MULTIPLE ABANDONMENTS** UNDER PARAGRAPH 73(1)(A) OF THE *PATENT ACT*, A WRITTEN REPLY TO **EACH REQUISITION** MUST BE RECEIVED WITHIN **6 MONTHS** AFTER THE ABOVE DATE.

This application has been examined taking into account applicant's correspondence received in this office on June 1, 2005.

The number of claims in this application is 14.

The examiner has identified the following defects in the application:

Re-References Applied:

PCT Application

WO 87/01481      March 12 1987      IPC4 G60F 3/06      Stein et al.

Reference Applied:

United States Patent

5 199 104 □      March 30 1993      US Class 395/145      Hirayama  
□ citation stemming from the list of references provided by the applicant

Hirayama discloses a portable computer that upon pressing a key saves the address of the page displayed in a predetermined area of RAM.

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### Obviousness

Claims 1-11 do not comply with section 28.3 of the *Patent Act*. The subject matter of these claims would have been obvious on the claim date to a person skilled in the art or science to which they pertain having regard to Hirayama and common general knowledge in the art.

Claim 1 is directed to an electronic book system and method that has a bookmark where a pointer points to a current page of a book, and upon opening the book the system determines if a pointer exists. If there is a pointer the book is opened to the bookmarked page, if no pointer exists then the bookmark is opened to the first page of the book. Electronic books were well known in the art on the claim date, see Stein et al. The bookmarking of page is merely the automation for a previously manual method of placing a bookmark in a paper book. The inventive feature of the claims could be argued to be the implementation of this feature in a computer. However, this does not involve an inventive step. As stated in MOPOP chapter 16 "using known or general purpose equipment and technology to automate fails to comply with section 28.3 of the Patent Act.". Furthermore it is well known to use pointers, a computer programming attribute that allows you to point to a memory address, to save the current page of being displayed (see Hirayama column 4 line 64-column 5 line 3). Therefore claims 1 and 8 are directed to a mere automation of placing a bookmark in a book and would have been obvious to a person skilled in the art.

Claim 2-7 and 9-11 are discussed below to show how the additional features are automations of a paper book and therefore lack inventive ingenuity.

In claims 2 and 10 the pointer is updated when a new page is displayed. This allows the system to open the book to the last page displayed. Traditionally a person would simply place a bookmark at the page he or she left off. Then open the book to the bookmarked page. This is more difficult to implement with a computer, however, a person skilled in the art would easily see that by keeping track of the current page it is easy to determine the last page read.

In claim 3 the processor saves the location of the pointer when the electronic book file is closed. This is equivalent to a person placing a bookmark at the page he or she left off.

In claims 4 and 11 when the book file is opened the processor displays the last page marked by the pointer. This is equivalent to a person opening the book at the bookmarked page.

In claim 5 the last page marked by the pointer is the last page displayed. This is equivalent to the last page bookmarked by the reader is the last page read.

In claim 6 the electronic book has a bookmark button that sets the pointer to the page being displayed when the button is depressed. This is equivalent to a person placing a bookmark at the page he or she is currently reading.

In claim 7 the location of the pointer is stored in the memory with an associated electronic book file. This is equivalent to a person reading multiple books and placing a different bookmark in each book.

In claim 9 the system receives a bookmark command and assigns a pointer to the currently displayed page of the electronic book, and stores the pointer with the electronic book. This is equivalent to person placing the bookmark at the page he or she is currently reading.

Therefore claims 1-11 are merely the automation of a previously manual process and cannot be viewed to involve inventive ingenuity.

#### Non-Statutory Subject Matter

The subject matter of this application is directed to a method of receiving a command to open an electronic book, determine if any page has a bookmark, if a bookmark exists then open the book to the bookmarked page, otherwise open the book to the first page. Claim 8 refers to a method of receiving a command and searching the memory for a pointer. However, the method does not produce an essentially economic result in relation to trade, commerce, or industry, in the meaning given by the Courts. The Canadian Patent Office considers a method to produce an essentially economic result in relation to trade when that method is a method of an inventive machine or when the method manufactures a vendible product. Displaying the bookmarked page of a book is not the operation of an inventive machine, nor does it create a vendible product. Using known technology (an electronic book) to display a bookmarked page is a mere automation as discussed above. Therefore it is not the use of an inventive machine. A method that does not produce an essentially economic result in relation to trade is not a manual or productive art, and is not an "art" under section 2 of the *Patent Act*. Therefore, the subject matter of claims 8-14 is nonpatentable.

#### Indefiniteness

Claim 1 is indefinite and does not comply with subsection 27(4) of the Patent Act. The claim recites a command to open an electronic book. The claim recites a memory storing one or more electronic book files, therefore it is not clear if the electronic book is the same as the electronic book file. Similar arguments can be made for claims 8, 9, and 12-14.

The examiner would like to take this opportunity to note that there is a typographical error in claim 6; "book mark" should be one word.

In view of the foregoing defects, the applicant is requisitioned, under subsection 30(2) of the *Patent Rules*, to amend the application in order to comply with the *Patent Act* and the *Patent Rules* or to provide arguments as to why the application does comply.

Under section 29 of the *Patent Rules*, the applicant is requisitioned to provide identification of any additional art cited during the prosecution of the United States Patent and Trademark Office, and European Patent Office applications describing the same invention on behalf of the applicant or on behalf of any other person claiming under an inventor named in the present application, subsequent to applicant's correspondence received on June 1, 2005 under paragraph 29(1)(a) of the *Patent Rules*.

To satisfy this requisition, applicant should provide all the preceding information or documents, or provide in accordance with subsection 29(3) of the *Patent Rules* a statement of reasons why any information or document is not available or known.

Kristina Deczky  
Patent Examiner  
819 934-5146